

The Examiner is requiring restriction to one of the following groups:

Group I: Claim 2, Polyampholytes;

Group II: Claim 3, Polyacids;

Group III: Claim 4, Polybases; and

Group IV: Claim 5, Polysalts.

The Examiner further required the election of a single discloses species from the following:

A: Hydroxylamine compound of formula XVa;

B: Hydroxlyamine compound of formula XVb; and

C: Hydrazine compound of formula XVI.

Accordingly, Applicants provisionally elect with traverse Group I, Claim 2, polyampholytes, and the species A compound of formula XVa.

The following claims read on the elected invention: 1, 2, 6, 7, 8, 9-20.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct, and there would be a serious burden if restriction is not required (M.P.E.P. § 803). The burden of proof is on the Examiner to provide reasons and/or examples to support any conclusion that the claims of the restricted groups are patentably distinct.

The claims of the restricted Groups I-IV are integrally linked as organic polyelectrolytes in the process for the production of leather. There is a technical relationship that involves the same features, and it is this technical relationship that defines the contribution which each of the groups taken as a whole makes over the prior art.

In the instantly claimed process the polyelectrolytes perform the same function in the production of leather. All of the electrolytes should be examined together on the merits, especially wherein the sole disclosed utility is that recited in the specification.

The Examiner asserts that Groups I-IV do not relate to a single inventive concept under PCT Rule 13.1 and 13.2 because they lack the same corresponding technical feature.

The Examiner has not considered that the claims in each group are considered to have related invention under 37 C.F.R. § 1.475(b) in which the inventions are considered to have unity of invention. Applicants submit that while Rule 13.1 and 13.2 are applicable, 37 C.F.R. § 1.475(b) provides in relevant part that “a national stage application containing claims to different categories of invention are considered to have unity of invention if the claims are drawn to … (3) a product, process specially adapted for the manufacture of said product …”

Moreover, Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office. As the Office has not shown any evidence that a Restriction Requirement should be required when the International Preliminary Examination Report did not, restriction is now believed to be improper. Unity of invention has to be considered in the first place only in relation to the independent claim. A dependent claim is one which contains all the features of another claim and is in the same category of claims as other claims. It does not matter if a dependent claim itself contains a further invention.

In chemical cases, a specific group of materials which do not necessarily belong to an otherwise class can be claimed together employing “Markush” language. The Markush practice sanctions the claiming together operable substances which could not be defined by generic language but which nevertheless have a community of chemical or physical characteristics. The members of the Markush group need only possess at least one property in common which is mainly responsible for their function of the claimed relationship. The same utility in a generic sense suffices.

Further, the M.P.E.P. § 803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

For the reasons recited above, Applicants request the Restriction Requirement be withdrawn.

Divisional applications filed thereafter claiming the non-elected species should not be subject to a double-patenting ground of rejection. 35 U.S.C. § 121, *In re Joyce*, (Comr. Pats. 1957), 115 USPQ 412.

Applicants further request that should the elected species be found allowable, the Examiner expand the search to include non-elected species.

Applicants submit that the above-identified application is now in condition for examination on the merits, and an early notice of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Norman F. Oblon



Paul J. Killos

Registration No. 58,014

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)